

REMARKS

The Office Action has been carefully reviewed. Claims 1-31 are pending. Claims 1, 2, 4, 6, 8, 10-14, 16, 19, 22-25, 28, 29 and 31 have been amended. No new matter has been included by these amendments. Support for these amendments can be found in the specification as originally filed at least at p. 21, lines 4-6;

Claims 4 and 13 have been objected to for certain informalities. *See* Office Action at ¶ 6. Claims 1-11, 12-13 and 28-30 have been rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which application regards as the invention. *See* Office Action at ¶ 11. Claims 1-31 have been rejected as allegedly unpatentable under 35 U.S.C. § 103 over U.S. Patent Application Publication No. 2002/0138418 to Zarin ("Zarin") in view of U.S. Patent No. 6,014,645 to Cunningham ("Cunningham"). *See* Office Action at ¶¶ 27-47. Applicant responds as follows.

I. Information Disclosure Statement.

Applicant thanks the Examiner for making the references listed on the Information Disclosure Statement and accompanying Form PTO/SB/08A that was filed on February 13, 2004 of record in this application, and for returning an initialed copy of the form.

II. Objections to the Drawings.

The Examiner objects to Figs. 1 and 2 as allegedly failing to show details as described in the specification. *See* Office Action at ¶ 4. Applicant has diligently studied the specification and Figs. 1 and 2, and has not identified any details described in the specification but not shown in these drawings. Applicant respectfully requests that the Examiner identify the details that are referenced in this objection so that necessary corrections can be made or so that the objections can be withdrawn.

Without regard to this objection, Applicant has submitted replacement drawing sheets for Figs. 1, 2, 3 and 4 and respectfully requests that the drawings be accepted. *See* Appendix A.

III. Objection to the Claims.

The Examiner has objected to Claims 4 and 13 for certain informalities. *See* Office Action at ¶ 6. Specifically, the Examiner objects to claim 4 for reciting the term "CTI." *Id.* Applicant has "spelled out" this term and respectfully requests that this objection be withdrawn.

The Examiner also objects to claim 13 as reciting a method. *Id.* Applicant has amended claim 13 to recite a system, and respectfully requests that this objection be withdrawn.

IV. Rejections under 35 U.S.C. § 112, Second Paragraph.

The Examiner has rejected claims 1-11, 12-13 and 28-30 under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which application regards as the invention. *See* Office Action at ¶ 11.

A. Claims 1-11.

Specifically, claim 1 has been rejected for reciting the phrases “a first interface unit for interfacing with the receiving unit and for communicating at least some of the information to portions of the system”; and “a second interface unit for communicating at least some consumer data to at least one third party.” *Id.* at ¶ 13. The Examiner states that “[i]t is unclear how the first interface unit passes the information to the second interface unit, or how the second interface unit receives the information.” *Id.*

Applicant has amended claim 1 to recite that both the first and the second interface units are in communication with the system and therefore consumer data is communicated through the system from the first interface unit to the second interface unit.

Claim 1 is also rejected “because it recites the phrase ‘a consumer having a unique identifier who contacts the system is offered at least one of pre-qualified financial instruments’ is unclear . . . [i]t is unclear how the consumer is offered a financial instrument.” *Id.* Claims 2-11 are rejected based on their dependency on claim 1. *Id.* Applicant has amended claim 1 and submits that this limitation has been more particularly pointed out in the claim as amended.

Applicant respectfully requests withdrawal of these rejections based on the amendment of claim 1.

B. Claims 3 and 4.

Claims 3 and 4 are rejected because claim 3 recites the “first interface unit” as “a human operator,” and claim 4 recites the “first interface unit” as “a processor.” *Id.* at ¶ 17. According to the Examiner, “[i]t is unclear if the first interface unit is ‘a human operator’ or ‘a processor.’” *Id.*

Applicant respectfully submits that the first interface unit is claimed to be a human operator in dependent claim 3, and a processor in dependent claim 4. Since these claims are not

dependent on each other, Applicant respectfully submits that the scope of each claim is clear. Further, Applicant submits that these claims comply with 35 U.S.C. § 112, second paragraph and respectfully request that these rejections be withdrawn.

C. Claims 8, 9 and 12.

Claims 8, 9 and 12 are rejected “because they recite the terms ‘suppression database’ and ‘suppression information.’” *Id.* at ¶ 19. According to the Examiner, these terms are “not definite because a person of ordinary skill in the art would be uncertain what ‘suppression database’ or ‘suppression information’ mean since they are unclear exactly what they mean.” *Id.* Further according to the Examiner, “the metes and bounds of the claim cannot be understood because of the lack of definiteness in the claim.” *Id.* Claim 13 is rejected because of its dependency on claim 12. *Id.* at ¶ 20.

Applicant has amended claims 8 and 12 to more particularly point out what is meant by the claim term “suppression information.” Applicant respectfully requests that these rejections be withdrawn.

D. Claims 10, 28 and 29.

Claims 10, 28 and 29 are rejected “because they recite the term ‘substantially’ is unclear because a person of ordinary skill in the art cannot ascertain exactly what it means.” *Id.* at ¶ 22. Further according to the Examiner, “the metes and bounds of the claim cannot be understood because of the lack of definiteness in the claim.” *Id.* Claim 30 is rejected because of its dependency on claim 28 *Id.* at ¶ 20.

Applicant respectfully submits that the term “substantially” does not render the scope of claims 10, 28 and 29 unclear. The MPEP states the following regarding use of the term “substantially” in a claim: “The term ‘substantially’ is often used in conjunction with another term to describe a particular characteristic of the claimed invention. It is a broad term. *In re Nehrenberg*, 280 F.2s 161, 126 USPQ 383 (CCPA 1960). The court held that the limitation ‘to substantially increase the efficiency of the of the compound as a copper extractant’ was definite in view of the general guidelines contained in the specification. *In re Mattison*, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). The court held that the limitation ‘which produces substantially equal E and H plane illumination patterns’ was definite because one of ordinary skill in the art would know what was meant by ‘substantially equal.’ *Andrew Corp. v. Gabriel Electronics*, 847

F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988).” MPEP § 2173.05(b)(D). Thus, the use of the claim term “substantially” does *not per se* render the scope of a claim unclear.

Here, the Examiner states with no explanation that “a person of ordinary skill in the art cannot ascertain exactly what [the term] means. Office Action at ¶ 22. Regardless, Applicant has amended claims 10, 28 and 29 and the term “substantially” has been deleted. Applicant notes that these amendments were not made in response to this rejection and were not made for reasons relating to patentability of these claims, but rather to more particularly point out and distinctly claim the invention. Applicant respectfully requests that these rejections be withdrawn.

V. Rejections Under 35 U.S.C. § 103.

Claims 1-31 have been rejected as allegedly unpatentable under 35 U.S.C. § 103 over Zarin in view of Cunningham. See Office Action at ¶¶ 27-47. A *prima facie* case of obviousness can be established by showing that the following three criteria are met: (1) there must be some suggestion or motivation to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all the claim limitations. See MPEP § § 2143 and 2143.03; citing *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991); *In re Royka*, 490 F.2d 1981 (CCPA 1974).

Additionally, under the Examination Guidelines For Determining Obviousness Under 35 U.S.C. In View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57,526 (October 10, 2007), the Examiner may establish a *prima facie* case of obviousness by setting forth factual findings concerning the state of the art and the teachings of the applied reference(s). See *id.* at 57,527. This includes determining “the scope and content of the prior art . . . ; differences between the prior art and the claims at issue . . . ; and the level of ordinary skill in the pertinent art . . .” *Id.*; see also MPEP § 2141; quoting *Graham v. John Deere*, 383 U.S. 1 (1966). The Examiner must then “provide an explanation to support an obviousness rejection under 35 U.S.C. 103 . . . 35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed.” *Id.*

For at least the following reasons, the Examiner has failed to establish a *prima facie* case of obviousness under either of these methods. Accordingly, for at least the following reasons, Applicant respectfully requests withdrawal of these rejections under 35 U.S.C. § 103(a).

A. Claims 14-30.

Claims 14-30 were rejected as allegedly unpatentable under 35 U.S.C. § 103 over Zarin in view of Cunningham. See Office Action at ¶¶ 27-45. With respect to claim 14, the Examiner states that “Zarin teaches a method for offering financial instruments to pre-qualified consumers (see Zarin, Abstract) comprising: receiving information related to personal identification information of a consumer (see Zarin, paragraph 51, figure 2/element 202); inquiring a third party based on the received information related to the consumer personal identification information whether the consumer has been pre-qualified for a financial instrument, the financial instrument associated with a financial institution (see Zarin, paragraph 52-53, figure 2/elements 204, 206); and offering the consumer the financial instrument for which he or she is pre-qualified, if the third party confirms that the consumer is pre-qualified for a financial instrument (see Zarin, paragraph 57, figure 2/elements 224, 226), wherein the third party maintains the consumer information relating to consumer pre-qualification for financial instruments (see Zarin, paragraph 48, figure 1B/elements 112, 114), wherein further the standards for the consumer pre-qualification are set by the financial institution (see Zarin, paragraph 48, figure 1B/element 114, where it says ‘financial account approval server.’” Office Action at ¶ 27. The Examiner states that “[a]lthough Zarin does not expressly disclose the financial institution standards for consumer pre-qualification, it specifically discloses a ‘financial account approval server . . . Cunningham teaches bank selection criteria for consumer pre-qualification (see col. 4, lines 23-43 including the matrix, figure 2/element 50) . . . it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teachings of Cunningham, related to bank selection criteria, in the Zarin’s invention to offer an improved system for more efficiently processing consumer request as described in Zarin in [sic] (paragraph 64).” *Id.*

Applicant respectfully submits that Zarin in combination with Cunningham does not support a *prima facie* case of obviousness in that the combination does not disclose each and every element of the claimed invention. Zarin discloses a “system and method for providing in real-time an immediately accessible customized transaction account via the internet.” Abstract. “[T]he system and method recognizes distinct access codes which are correlated to the credit profile of a person accessing an on-line application system via a computer network.” *Id.* In Zarin, a prospective card holder or pre-existing card holder accesses a system that is maintained

by a card provider server, which Zarin discloses to be a "transaction account provider" server. Para. [0011]. The "transaction account provider server facilitates verification of the validity of the pre-approval code prior to allowing the prospective card holder to enroll in a pre-approved individually tailored . . . system or program offered by the provider." *Id.* The pre-existing card holder provides information to the card provider server that identifies the person as a pre-existing customer of the provider. Para. [0012]. The card provider may maintain a separate "solicitation database" which stores identifying information of the accessing party and also special offers for which the accessing party is pre-approved. Para. [0013]. The special offer is provided to the accessing party for acceptance. *Id.* If the accessing party accepts the special offer, an application is processed and the accessing party is provided in substantially real time with transaction account information that may be available for immediate use. Para. [0013]. In each embodiment disclosed in Zarin, the system, including the transaction account server and the solicitation database, are maintained by the card provider. Paras. [0010]-[0017].

Zarin, however, does not disclose the limitations of claim 14 of receiving transmitted consumer information that has been transmitted regardless of a request by the consumer to transmit the consumer information, inquiring a third party based on the received information related to the consumer personal identification information whether the consumer has been pre-qualified for a financial instrument, the financial instrument associated with a financial institution; and offering the consumer the financial instrument for which he or she is pre-qualified, if the third party confirms that the consumer is pre-qualified for a financial instrument, wherein the third party maintains consumer information relating to consumer pre-qualification for financial instruments, wherein further the standards for the consumer pre-qualification are set by the financial institution. Rather, in Zarin, in each embodiment disclosed in Zarin, the system, including the transaction account server and the solicitation database, are maintained by the card provider, and the applicant contacts the system and enters personal information into the system. Paras. [0010]-[0017].

Cunningham discloses a system for presenting financial card offers to potential customers. Abstract. An applicant accesses the system of Cunningham and provides personal and financial data, which are analyzed by the system in conjunction with data from outside

sources (disclosed, for example, to be credit bureaus). *Id.* The system determines a “financial risk rating” for the applicant, which is used to locate appropriate offers for the applicant. *Id.*

However, Cunningham does not cure the deficiencies of Zarin. Specifically, Cunningham does not disclose the limitations of claim 14 of receiving transmitted consumer information that has been transmitted regardless of a request by the consumer to transmit the consumer information, inquiring a third party based on the received information related to the consumer personal identification information whether the consumer has been pre-qualified for a financial instrument, the financial instrument associated with a financial institution; and offering the consumer the financial instrument for which he or she is pre-qualified, if the third party confirms that the consumer is pre-qualified for a financial instrument, wherein the third party maintains consumer information relating to consumer pre-qualification for financial instruments, wherein further the standards for the consumer pre-qualification are set by the financial institution, which are also not disclosed in Zarin.

Further, there is no motivation, teaching or suggestion to combine Zarin and Cunningham, and also there is no reasonable expectation of success in such a combination. The specification discloses that previous systems are limited by current regulations regarding the access and use of consumer credit information, such that an entity that is not an agent of a credit bureau that takes possession of the credit information of an individual is committed to make that individual a firm offer of credit. Specification at p. 2, line 19 to p. 3, line 3. The invention permits the tailoring of a financial product for a consumer by qualifying a consumer for a financial product according to the consumer's current credit information, without the concomitant required offer of credit to the consumer. In contrast, systems such as Zarin and Cunningham that are operated by the provider of the credit do not have the option of whether to offer a consumer a product because they already have taken possession of the consumer's credit information. Further, Zarin and Cunningham both respond to a request by a consumer, whereas Claim 14 expressly claims that consumer information is transmitted and used to determine if the consumer is qualified to receive an offer of a financial instrument, regardless of a request by the consumer. Accordingly, Zarin in combination with Cunningham would not result in the claimed invention of claim 14 even if combined.

Accordingly, the combination of Zarin and Cunningham does not support a *prima facie* case of obviousness under this approach.

B. Claims 1-13 and 31.

Claims 1-13 and 31 were rejected as allegedly unpatentable under 35 U.S.C. § 103 over Zarin in view of Cunningham for the same reasons as claims 14-30. *See* Office Action at ¶¶ 46-47. Applicant respectfully submit that these references do not disclose each and every limitation of claims 1-13 and 31 for the same reasons as discussed *supra* for claims 14-30, and therefore do not support a *prima facie* case of obviousness. Since the cited references, alone or in combination, do not disclose each and every limitation of claims 1-13 and 31, Applicant submits that claims 1-13 and 31 are allowable over Zarin and Cunningham.

C. The Examiner has not set forth a case for obviousness under the new Examination Guidelines.

The Examiner has also not set forth a case of obviousness of claims 1-31 under the new Examination Guidelines as set forth at 72 Fed. Reg. 57,526 (October 10, 2007). There are no factual findings concerning the state of the art and the teachings of the applied reference(s) to establish obviousness, as required. *See id.* at 57,527. There is no “explanation to support an obviousness rejection under 35 U.S.C. 103 . . . 35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed.” *Id.*

The new Guidelines state that some rationale must be set forth that outlines the reasoning why an invention is obvious. *See id.* at 57,528 (III). Suggested but non-inclusive rationales are described including:

1. Combining prior art elements according to known methods to yield predictable results;
2. Simple substitution of one known element for another to obtain predictable results;
3. Use of known techniques to improve similar devices (methods, or products) in the same way;
4. Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
5. “Obvious to try” - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

6. Known work in one field of endeavor that may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and
7. Some teaching, suggestion or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicant has already addressed the last rationale listed above and respectfully submit that the Examiner has not set forth any of the other rationales (or any other rationales either) to support a finding of obviousness. Further, there are no factual findings set forth in the Final Rejection regarding the scope and content of the prior art; ascertainment of the differences between the claimed invention and the prior art; and resolution of the level of ordinary skill in the pertinent art, all three of which are required to support a finding of obviousness by the Examiner.

CONCLUSION

Applicant respectfully submits that claims 1-31 are in condition for allowance and request allowance of the same.

This Amendment and Response has been filed within three months of the mailing date of the Office Action and it is believed that no fees are due for this filing. If any fees are determined to be due, the Commissioner is hereby authorized to deduct such fees from the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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Appendix I - Replacement Drawings